

Remarks

The following remarks are submitted to address the issues raised in the Office Action mailed April 14, 2004 and in the Advisory Action mailed June 29, 2004.

Claims 1-39 are pending in the present application.

Applicants respectfully request entry of the amendments filed in the Response after final on June 9, 2004, in addition to the claim amendments listed above.

Claims 25-38 were withdrawn from consideration by the Examiner after Applicants elected the compound of Example 9.

In the Advisory Action mailed June 29, 2004, the rejection of claims 1, 2, 19-24, and 39 under 35 U.S.C. § 112, second paragraph, as being indefinite was withdrawn.

In the Advisory Action mailed June 29, 2004, the rejection of claims 3-18 for using "comprises" instead of "is" was withdrawn.

Claims 1, 2, 19-24, and 39 stand rejected under 35 U.S.C. § 103(a) as being obvious over US Pat. No. 5,703,092 to Xue et al.

Claims 3-18 are considered to be allowable by the Examiner but are objected to as being dependent on a rejected base claim.

No new matter has been added. The foregoing rejections and other items are addressed in the following paragraphs. Consideration of the pending claims is respectfully requested in view of the following comments.

Claim Amendments

Claim 1 has been amended to remove duplicate groups under R₉ and R₁₀.

Claim 2 has been amended to delete the conjunction "and" in item s) for R₅, R₆, R₇, and R₈.

Claims 1, 2, 19-24, and 39 - 35 U.S.C. § 103(a)

The rejection of claims 1, 2, 19-24, and 39 under 35 U.S.C. § 103(a) as being obvious over US Pat. No. 5,703,092 to Xue et al. is respectfully traversed.

In Applicants' previous response filed Jan. 2, 2004, claims 1 and 2 were amended to include the limitation "wherein at least one of R₅, R₆, R₇, and R₈ is -Y-C₁₋₆ alkylene-NR₁₃R₁₄." Contrary to the Examiner's statement, Applicants believe that it would not have been obvious to one of ordinary skill in the art to modify the compounds having benzimidazole rings disclosed in Xue to include at least one group of the formula -Y-C₁₋₆ alkylene-NR₁₃R₁₄.

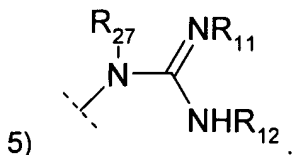
Further, contrary to the Examiner's statement on page 5 of the Office Action mailed April 14, the genus of benzimidazole compounds described in Xue does not describe each and every element of the compounds of Formula (I) in claim 1 of the present application. Xue also does not suggest or provide any motivation to modify the compounds of Formula (I) in Xue to arrive at the compounds of Formula (I) in claim 1 of the present application.

In claim 1 of the present application, the group R₂ of benzimidazoles of Formula (I) is selected from a group consisting of

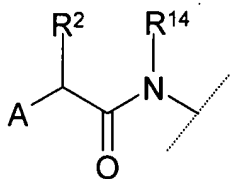
- a) a group of the formula -N(R₉R₁₀), -NHC(O)R₉, or -NHC(O)OR₉;
 - b) a group of the formula -OR₉;
 - c) a group of the formula -SR₉, -SOR₉, -SO₂R₉, -SO₂NHR₉, or -SO₂N(R₉R₁₀);
- wherein

R₉ and R₁₀ are independently selected from the group consisting of

- 1) -H; 2) -aryl; 3) -C₁₋₆ alkyl; 4) -C₁₋₆ alkylaryl; and



In Xue, the compounds of Formula (I) include the amide group



wherein A is selected from $-N(R^8)C(R^9)(R^{9a})CO_2H$, $-CH(R^{11})C(R^9)(R^{9a})CO_2H$, or $-C(R^1)(R^{1a})CONHOH$. This amide group in combination with A, R^2 , and R^{14} does not describe the R_2 group in the compounds of Formula (I) in claims 1, 2, 19-24, and 39 of the present application.

For example, in the elected species of the present application (recited in claim 11) the R_2 group is a tert-butoxycarbonylamino. The amide group in Xue does not describe the tert-butoxycarbonyl amino functional group.

The amide group in Xue also requires that the A group be terminated with a $-CO_2H$ or a $-CONHOH$ group whereas the R_2 group in claim 1 of the present application is not terminated with a $-CO_2H$ or a $-CONHOH$ group. It would not have been obvious to one of ordinary skill in the art to modify the amide group in Xue to include a group as described in R_2 in claim 1 of the present application.

As a result, Applicants respectfully request that the Examiner withdraw the rejection of claims 1, 2, 19-24, and 39 under 35 U.S.C. § 103(a) as being obvious over Xue.

Claims 3-18 - Objection

Claims 3-18 were considered to be allowable by the Examiner but were objected to as being dependent on a rejected claim. Applicants respectfully traverse the objection to claims 3-18.

Claims 3-18 depend from claim 2 and ultimately depend from claim 1. As described above, Applicants have traversed each and every rejection of claims 1 and 2.

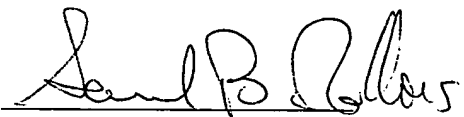
Fees

This complete response is being filed within 5 months of the mailing of the Office Action on April 14, 2004. Applicants have included with this Request for Continued Examination a Petition for Extension of Time of 2-months under 37 C.F.R. § 1.136(a).

Conclusion

In conclusion, Applicants request entry of the amendments, consideration of the Remarks, and passage of the application to issuance.

Date: August 25, 2004

Respectfully submitted,
By: 
Samuel B. Rollins
Reg. No. 52,180

Samuel B. Rollins
Patent Counsel
TransTech Pharma, Inc.
4170 Mendenhall Oaks Pkwy, Suite 110
High Point, NC 27265
336-841-0300, ext. 159